

T T A B

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD



Baxter International Inc.,

Opposer,

v.

Inviro Medical Devices Ltd.,

Applicant.

Opposition No. 91150298
Application No. 76/151,380



12-22-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #78

**INVIRO'S MOTION TO AMEND ANSWER AND AMEND
COUNTERCLAIM FOR CANCELLATION**

In accordance with Rule 15(a), Fed.R.Civ.P., applicant Inviro Medical Devices Ltd. ("Inviro") hereby moves the U.S. Trademark Trial and Appeal Board ("the Board") for leave to amend its Answer and Counterclaim.

More specifically, Inviro seeks leave to add a second counterclaim for the cancellation of INTERLINK Trademark Registration No. 1,821,178 that opposer Baxter International Inc. ("Baxter") has pled in this opposition. During discovery, Baxter has produced information that confirms the fraudulent procurement and the fraudulent maintenance of this registration. As a result, the registration should be cancelled.

A counterclaim (Second Counterclaim) to this effect has been added to Inviro's proposed amended Answer and Counterclaim, which is attached as Exhibit A. No other changes have been made to the Answer except for corrections in the wording of the First Counterclaim, as required by recent Baxter information. There is no fee required because Inviro has previously paid the cancellation fee for this registration.

Baxter has not consented to this motion.

A. Justice Requires Amendment

As stated by Rule 15 of the Federal Rules of Civil Procedure, leave to amend "shall be freely given when justice so requires." In this case, justice requires amendment.

As noted above, Inviro seeks leave to add a counterclaim for the cancellation of INTERLINK Trademark Registration No. 1,821,178 that Baxter has pled in this opposition. During a recent discovery deposition on December 15, 2003, Baxter provided information that confirms the fraudulent procurement and the fraudulent maintenance of this registration. As a result, the registration should be cancelled.

More specifically, in its application declaration in 1993 (upon which Registration No. 1,821,178 was based), Baxter swore that it had used the INTERLINK trademark on "drug vials" and "drug vial stoppers" as set forth in Registration No. 1,821,178. In addition, in its Section 8 Declaration in 1999 for Registration No. 1,821,178, Baxter swore that it was currently using the INTERLINK trademark on "drug vials" and "drug vial stoppers" as set forth in Registration No. 1,821,178. Further, in its Section 15 Declaration in 1999, Baxter swore that it was using and had continuously used for the last five years the INTERLINK trademark on "drug vials" and "drug vial stoppers" as set forth in Registration No. 1,821,178. Baxter's application declaration in 1993, Baxter's Section 8 declaration in 1999, and Baxter's Section 15 declaration in 1999 were false and fraudulent. According to Baxter's sworn testimony on December 15, 2003, Baxter has never used the INTERLINK trademark on "drug vials" or "drug vial stoppers" as set forth in Registration No. 1,821,178. (Baxter's sworn testimony has not yet been transcribed, but will be submitted as **Exhibit B** as soon as it has been transcribed.) Furthermore, Baxter has confirmed with sworn testimony on December 15, 2003, that it has never informed the U.S. Trademark Office of these facts. (Again, Baxter's sworn testimony has not yet been transcribed, but will be

submitted as an Exhibit as soon as it has been transcribed.) These Baxter actions constitute the fraudulent procurement of Registration No. 1,821,178 as well as the fraudulent maintenance of Registration No. 1,821,178. Accordingly, Inviro should be permitted to amend its Answer and Counterclaim to seek the cancellation of Registration No. 1,821,178.

B. Prompt Pleading of Counterclaim

In accordance with Trademark Rule 2.106(b)(2)(i), if the grounds for a counterclaim are not known at the time the Answer is filed, but are learned during the course of the opposition, then the counterclaim can be pled after the grounds for the counterclaim are learned. Inviro was not aware of Baxter's fraudulent procurement and fraudulent maintenance of Registration No. 1,821,178 when Inviro filed its Answer. As noted above, however, Inviro discovered this information in a Baxter deposition held on December 15, 2003. Thus, Inviro is promptly seeking leave to amend its Answer and Counterclaim to conform to the evidence.¹

C. No prejudice

The granting of this motion will not prejudice Baxter. Indeed, Baxter is the party who has produced the information relevant to this motion. As a result, no prejudice will occur to Baxter by the granting of this motion.

Conclusion

Baxter's recent testimony has revealed that it fraudulently procured Registration No. 1,821,178 and fraudulently maintained Registration No. 1,821,178. Justice requires that Inviro be permitted to amend its Answer and Counterclaim and seek the cancellation of the registration on this ground.

¹ The reason that Inviro did not file this motion one week earlier is because the parties were holding confidential settlement discussions that may have avoided the filing of this motion. Those discussions recently ended.

Respectfully submitted,

Date: 12/22/03




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Attorneys for Applicant,
Inviro Medical Devices Ltd.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of INVIRO'S MOTION TO AMEND ANSWER AND AMEND COUNTERCLAIM FOR CANCELLATION was served this 22 day of Dec, 2003, via first class mail, postage prepaid, on counsel for Opposer:

Elizabeth Diskin
LEYDIG, VOIT & MAYER, LTD.
Two Prudential Plaza - Suite 4900
Chicago, Illinois 60601



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

BAXTER INTERNATIONAL INC.)	
)	
Opposer,)	
)	Opposition No. 91150298
v.)	
)	Application No. 76-151380
INVIRO MEDICAL DEVICES LTD.)	
)	
Applicant.)	

12-22-2003
U.S. Patent & TMO/c/TM Mail Rcpt Dt. #78

**APPLICANT'S AMENDED ANSWER TO AMENDED NOTICE OF OPPOSITION
AND AMENDED COUNTERCLAIM TO CANCEL OPPOSER'S PLEADED
REGISTRATION NOS. 1,721,708, 1,812,016 and 1,821,178**

Applicant, INVIRO MEDICAL DEVICES LTD., hereby answers the Amended Notice of Opposition in the following manner:

1. Applicant admits the allegations in Paragraph 1 of the Opposition.
2. Applicant lacks sufficient knowledge to form a belief concerning any of the allegations in Paragraph 2 of the Opposition and, therefore, denies all of the allegations in Paragraph 2 and leaves Opposer to its proof.
3. Applicant lacks sufficient knowledge to form a belief concerning any of the allegations in Paragraph 3 of the Opposition, including the copies of portions of three registrations attached to the Opposition as Exhibit A, and, therefore, denies all of the allegations in Paragraph 3 and leaves Opposer to its proof.

EXHIBIT

A

4. Applicant lacks sufficient knowledge to form a belief concerning any of the allegations in Paragraph 4 of the Opposition and, therefore, denies all of the allegations in Paragraph 4 and leaves Opposer to its proof.

5. Applicant lacks sufficient knowledge to form a belief concerning any of the allegations in Paragraph 5 of the Opposition and, therefore, denies all of the allegations in Paragraph 5 and leaves Opposer to its proof.

6. Applicant lacks sufficient knowledge to form a belief concerning any of the allegations in Paragraph 6 of the Opposition and, therefore, denies all of the allegations in Paragraph 6 and leaves Opposer to its proof, with the exception that Applicant admits it has a pending application U.S. Serial No. 76/151380 covering "medical devices, namely, cannulae, medical, hypodermic, aspiration and injection needles, medical, hypodermic, aspiration and injection syringes, connectors, ports, catheters and injection sites."

7. Applicant lacks sufficient knowledge to form a belief concerning any of the allegations in Paragraph 7 of the Opposition and, therefore, denies all of the allegations in Paragraph 7 and leaves Opposer to its proof, with the exception that Applicant admits its application covers "medical devices, namely, cannulae, medical, hypodermic, aspiration and injection needles, medical, hypodermic, aspiration and injection syringes, connectors, ports, catheters and injection sites."

8. Applicant lacks sufficient knowledge to form a belief concerning any of the allegations in Paragraph 8 of the Opposition and, therefore, denies all of the allegations in Paragraph 8 and leaves Opposer to its proof.

9. Applicant lacks sufficient knowledge to form a belief concerning any of the allegations in Paragraph 9 of the Opposition and, therefore, denies all of the allegations in Paragraph 9 and leaves Opposer to its proof.

10. Applicant denies the allegation in the second sentence of Paragraph 10 of the Opposition that reads: "[such customers] would likely believe that Applicant's goods were somehow related to, complementary to, or otherwise authorized by Opposer," and leaves Opposer to its proof. Applicant lacks sufficient knowledge to form a belief concerning any other allegations in Paragraph 10 of the Opposition and, therefore, denies all of the allegations in Paragraph 10 and leaves Opposer to its proof.

11. Applicant denies that its mark is very similar in sight, sound and commercial impression to Opposer's marks, and is identical in product and nature of use, and leaves Opposer to its proof. In this regard, Applicant notes that there are a plethora of third party "LINK" trademark applications and registrations in the United States Trademark Office in Class 10 -- which severely limits the scope of any alleged "LINK" rights that Opposer claims. See, e.g., Exhibit 1. In fact, Opposer was not the first party to use or register a "LINK" trademark for Class 10 medical goods in the United States. Moreover, no party can claim any exclusive rights in the generic/descriptive term "LINK" as used with Class 10 medical goods in the United States. Furthermore, Applicant's distinctive Class 10 term ULTRA as used in its trademark is completely different than Opposer's Class 10 term INTER in appearance, pronunciation, connotation and commercial impression. These factors and others preclude any likelihood of confusion, mistake or deception under 15 U.S.C. § 1052(d). Finally, Applicant lacks sufficient knowledge to form a belief concerning any of the other allegations in Paragraph 11 of the

Opposition and, therefore, denies all of the allegations in Paragraph 11 and leaves Opposer to its proof.

AFFIRMATIVE DEFENSES

12. The differences between Opposer's INTERLINK marks and Applicant's mark and/or the goods with which these marks are used or intended to be used precludes any likelihood of confusion, mistake or deception.

13. Because of the generic/descriptive nature of the word "LINK," Opposer's rights in its cited LINK registrations, if any, are limited in scope.

14. In view of third party usage, applications for and registration of marks including the word "LINK" for various types of medical goods in Class 10, and the lack of Opposer's policing efforts, Opposer is entitled only to a narrow scope of protection for its alleged "LINK" trademarks. See, for example, the plethora of third party "LINK" U.S. trademark applications and registrations identified in the computer printouts attached as Exhibit 1 hereto.

APPLICANT'S AMENDED COUNTERCLAIM FOR CANCELLATION OF OPPOSER'S PLEADED REGISTRATIONS

A. First Counterclaim

Applicant hereby counterclaims to cancel Opposer's pleaded Registration Nos. 1,721,708, 1,812,016 and 1,821,178 pursuant to Trademark Rule 2.106 (b)(2)(i). As grounds in support of the counterclaim, Applicant alleges as follows:

15. Opposer Baxter International Inc. ("Baxter") has asserted three INTERLINK trademark registrations in this opposition, i.e., Registration Nos. 1,721,708, 1,812,016 and 1,821,178.

16. On information and belief, Baxter has licensed or allowed various third parties to use the INTERLINK trademark that is the subject of the foregoing three registrations.

17. On information and belief, Baxter has failed to exert quality control over the third parties' usage of the INTERLINK trademark and the corresponding third parties' goods and/or services.

18. On information and belief, Baxter's failure to exert quality control amounts to the improper "naked licensing" of its INTERLINK trademark. As a result, the three INTERLINK registrations, i.e., Registration nos. 1,721,708, 1,812,016 and 1,821,178, should be cancelled.

B. Second Counterclaim

Applicant hereby counterclaims to cancel Opposer's pleaded Registration No. 1,821,178 pursuant to Trademark Rule 2.106 (b)(2)(i). As grounds in support of the counterclaim, Applicant alleges as follows:

19. Opposer Baxter International Inc. ("Baxter") has asserted the INTERLINK Trademark Registration No. 1,821,178 in this opposition.

20. In its application declaration in 1993 (upon which Registration No. 1,821,178 was based), Baxter swore that it had used the INTERLINK trademark on "drug vials" and "drug vial stoppers" as set forth in Registration No. 1,821,178. In addition, in its Section 8 Declaration in 1999 for Registration No. 1,821,178, Baxter swore that it was currently using the INTERLINK trademark on "drug vials" and "drug vial stoppers" as set forth in Registration No. 1,821,178. Further, in its Section 15 Declaration in 1999, Baxter swore that it was using and had continuously used for the last five years the INTERLINK trademark on "drug vials" and "drug vial stoppers" as set forth in Registration No. 1,821,178. Baxter's application declaration in

1993, Baxter's Section 8 declaration in 1999, and Baxter's Section 15 declaration in 1999 were false and fraudulent. According to Baxter's sworn testimony on December 15, 2003, Baxter has never used the INTERLINK trademark on "drug vials" or "drug vial stoppers" as set forth in Registration No. 1,821,178. Furthermore, Baxter has confirmed with sworn testimony on December 15, 2003, that it has never informed the U.S. Trademark Office of these facts. These Baxter actions constitute the fraudulent procurement of Registration No. 1,821,178 as well as the fraudulent maintenance of Registration No. 1,821,178. Accordingly, Registration No. 1,821,178 should be prejudicially cancelled.

WHEREFORE, Applicant prays that the opposition be dismissed and that the counterclaims for cancellation be granted with Registration Nos. 1,721,708, 1,812,016 and 1,821,178 being cancelled.

Respectfully submitted,

NIXON & VANDERHYE P.C.

Dated: 12/22/03

By: 

Duane M. Byers

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CERTIFICATE OF SERVICE

It is hereby certified that a true copy of the foregoing APPLICANT'S AMENDED ANSWER TO AMENDED NOTICE OF OPPOSITION AND AMENDED COUNTERCLAIM TO CANCEL OPPOSER'S PLEADED REGISTRATION NOS. 1,721,708, 1,812,016 and 1,821,178_ was served on counsel for Opposer by depositing same in the United States mail, first class, postage pre-paid, this 22 day of December 2003, addressed to:

Elizabeth Diskin
LEYDIG, VOIT & MAYER, LTD.
Two Prudential Plaza
Suite 4900
Chicago, Illinois 60601



Duane M. Byers